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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,716	07/24/2000	Christopher Thomas Sepe	018563-003300US	6440
46718 7590 01/05/2007 TOWNSEND AND TOWNSEND AND CREW, LLP (018563) TWO EMBARCADERO CENTER, EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER MEINECKE DIAZ, SUSANNA M	
			ART UNIT 3694	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

09/621,716

**Applicant(s)**

SEPE, CHRISTOPHER THOMAS

**Examiner**

Susanna M. Diaz

**Art Unit**

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 13, 2006 has been entered.

Claim 12 has been cancelled.

Claims 21 and 22 have been added.

Claims 1-11 and 13-22 are pending.

### ***Response to Arguments***

2. Applicant's arguments filed November 13, 2006 have been fully considered but they are not persuasive.

Applicant continues to argue that neither Bianco nor McMenimen qualify as prior art (pages 7-8 of Applicant's response). The Examiner respectfully disagrees. The Examiner has established a *prima facie* case that claims 1-20 are unpatentable over Bianco et al. (US 2002/0082865) in view of McMenimen et al. (US 2002/0077850) under 35 U.S.C. 103(a). The fact that both Bianco and McMenimen claim priority to their respective provisional applications means that Bianco and McMenimen are potentially granted a § 102 date back to the filing date of their respective provisional applications

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(for purposes of applying them as prior art). Furthermore, even if all of the subject matter of a non-provisional application is not fully disclosed in a provisional application to which the non-provisional claims priority, the subject matter that *is* fully supported by the provisional application is granted priority back to the filing date of the provisional application (i.e., a continuation-in-part type of analysis is used to assess the granted priority date for the disclosed subject matter in the non-provisional application). As a matter of fact, the Examiner did point out support in the provisional application of McMenimen for the teachings relied upon in the art rejection. Applicant has not established which part of the disclosure of Bianco or McMenimen **relied on in the art rejection** of the claims in the instant application are allegedly not supported by the respective provisional applications of both Bianco and McMenimen; therefore, Applicant's arguments are not persuasive.

Applicant argues that neither Bianco nor McMenimen discloses "a server that is configured to automatically communicate manufacturing progress with a patient's computer or to perform patient scheduling when one or more dental appliances reach a predetermined manufacturing progress" (pages 9-10 of Applicant's response). It should be noted that some of the claim amendments have broadened the claim scope. For example, claim 1 previously recited "the server communicating manufacturing progress information with the patient computer and to perform patient scheduling when one or more dental appliances reach a predetermined manufacturing progress." The phrase "configured to" fails to expressly require that the associated functionality be performed. In other words, the server now only needs to be capable of automatically

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communicating manufacturing progress. Additionally, it was the combination of Bianco and McMenimen that was used to address the limitation in question. As stated in the art rejection, in the provisional application, McMenimen describes an automated inventory monitoring system in which the "patient and/or the ordering entity can monitor the status of the build process, expected completion, and shipment delivery status" (page 2 of the section entitled "Responsive Manufacturing and Inventory Control"). McMenimen is analogous to Bianco and provides a solution reasonably pertinent to the problem at hand in Bianco; therefore, the Examiner maintains that one of ordinary skill in the art at the time of Applicant's invention would have indeed found it obvious and been motivated to combine the teachings from these references to address the claim limitation in question. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It should also be noted that the word "automatically" refers to something that is "done or produced as if by a machine" (definition of "automatic" from Merriam Webster's Collegiate® Dictionary (10<sup>th</sup> ed)). McMenimen describes an automated system for alerting patients and ordering entities to the status of build-to-order, implantable medical devices; therefore, McMenimen automatically (i.e., through the use of an automated system) communicates manufacturing progress information. Furthermore, claim 1 only requires that a server be capable of automatically communicating manufacturing

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progress. Consequently, any server that transmits information (such as the servers disclosed by Bianco and McMenimen) is capable of transmitting information of any kind (including manufacturing progress information).

In summary, Applicant's arguments are non-persuasive.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-11 and 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bianco et al. (US 2002/0082865) in view of McMenimen et al. (US 2002/0077850).

Regarding claims 1 and 20, Bianco discloses a patient scheduling system in which patients can access a personal account online to receive task reminders, schedule medical appointments, purchase a medical product, etc. (¶¶ 16-22). Since each patient must log in, there are presumably a plurality of patients and patient computers connected to the network (Figs. 1, 4; ¶ 97), which may be a wide area network (¶ 81). Bianco states that "the medical event may be an operation...but should be understood generally to encompass any type of medical events" (¶ 78). When a patients logs in to the system, he/she may be reminded to complete various pre-procedure or post-procedure tasks, such as scheduling an appointment, scheduling the

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procedure, or ordering a medical product (§§ 94, 95, 108, 117, 121, 140). Appointment reminders may also be requested (§§ 108, 140) and messages may be sent to the patient's e-mail inbox (§ 109). While Bianco reminds patients to order medical products and schedule appointments or medical procedures, Bianco does not expressly integrate the scheduling with the manufacturing process. However, the Examiner submits that when a scheduled procedure requires installation, insertion, or some other use of an ordered medical product, then the medical product must be made available in time for the scheduled procedure. In other words, there must be some understanding of whether a needed medical product will be available in time for the related medical procedure. While this practice (i.e., checking to make sure all supplies are ready for a medical procedure) was commonly performed by hand, McMenimen incorporates by reference the full disclosure of Provisional Patent Application No. 60/180,289 (to which McMenimen claims priority). In the provisional application, McMenimen describes an automated inventory monitoring system in which the "patient and/or the ordering entity can monitor the status of the build process, expected completion, and shipment delivery status" (page 2 of the section entitled "Responsive Manufacturing and Inventory Control"). Since it is well-known for medical procedures to be delayed until necessary medical products become available and McMenimen describes an automated system for alerting patients and ordering entities to the status of build-to-order, implantable medical devices, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Bianco to allow a logged-on patient to receive manufacturing progress information with the patient

computer and perform patient scheduling over a wide area network when one or more dental appliances reach a predetermined manufacturing progress in order to more efficiently facilitate scheduling of a medical procedure when needed build-to-order medical devices are expected to become available, thereby mitigating wastes in time and effort that might otherwise be spent rescheduling medical procedures when the delivery of required medical devices is delayed. It should be noted that "predetermined manufacturing progress" could refer to any part of the manufacturing process, including the beginning, an intermediate stage, and the end (i.e., the product is completed). McMenimen shows that the patient and/or ordering entity can track the device anytime during the build process, including expected completion, which is an example of "predetermined manufacturing progress."

Further regarding claims 1 and 20, neither Bianco nor McMenimen expressly teaches that the medical product comprises one or more dental appliances; however, Official Notice is taken that it is old and well-known in the art of medical devices that dental appliances are commonly ordered build-to-order medical products. The claimed functionality and that of Bianco and McMenimen would be the same regardless of what type of device is manufactured for the patient; therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt the Bianco-McMenimen combination to supply one or more dental appliances in order to expand its customer base to the dental industry. Additionally, the limitations regarding the dental industry and dental appliances *per se* merely recite various intended uses of the invention. A recitation of the intended use of the claimed



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invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The claimed recitations of intended use neither result in a structural difference between the claimed invention and the prior art nor in a manipulative difference as compared to the prior art; therefore, the claimed invention is not deemed to be patentably distinct over the prior art.

As per claims 2-5, Bianco's server can generate reminders and e-mail messages for the patients while McMenimen apprises the patient and ordering entity of medical device manufacturing status (as discussed above). More specifically, McMenimen allows patients and ordering entities to access manufacturing progress information [Claim 2] when the appliances reach a predetermined manufacturing stage (page 2 of the section entitled "Responsive Manufacturing and Inventory Control"), [Claim 3] wherein the appliances are marked as part of the manufacturing process (page 2 of the section entitled "Responsive Manufacturing and Inventory Control"), [Claim 4] when the appliances reach one or more intermediate stages of manufacturing (page 2 of the section entitled "Responsive Manufacturing and Inventory Control"), [Claim 5] wherein the information is related to manufacturing progress (page 2 of the section entitled "Responsive Manufacturing and Inventory Control"). The Examiner further submits that a device ordering entity is often a treating professional since the treating professional

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will likely be installing the device. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt the Bianco-McMenimen combination such that the server sends a message to a patient when the appliances reach a predetermined manufacturing stage (claim 2), wherein the server sends a message to a patient when the appliances are being marked (claim 3), wherein the server sends a message to a treating professional when the appliances reach one or more intermediate stages of manufacturing (claim 4), wherein the server sends an electronic mail message to transmit information relating to manufacturing progress (claim 5) in order to more efficiently facilitate scheduling of a medical procedure when needed build-to-order medical devices are expected to become available, thereby mitigating wastes in time and effort that might otherwise be spent rescheduling medical procedures when the delivery of required medical devices is delayed.

Regarding claim 6, Bianco discloses that the server maintains calendar pages for the treating professionals (Figs. 5-6B; ¶¶ 81, 97, 98).

As per claim 7, Bianco's server invites a patient to access an on-line calendar and schedule an appointment (¶¶ 94, 95, 108, 117, 121, 140); however, Bianco does not expressly send such an invitation or reminder when the appliances reach the last stage of manufacturing. As discussed above, it is well-known for medical procedures to be delayed until necessary medical products become available and McMenimen describes an automated system for alerting patients and ordering entities to the status of build-to-order, implantable medical devices. Therefore, the Examiner submits that it

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would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt the Bianco-McMenimen combination to invite a patient to access an on-line calendar and schedule an appointment when the appliances reach the last stage of manufacturing in order to more efficiently facilitate scheduling of a medical procedure when needed build-to-order medical devices are expected to become available, thereby mitigating wastes in time and effort that might otherwise be spent rescheduling medical procedures when the delivery of required medical devices is delayed.

Regarding claim 8, Bianco discloses a network of treating professionals coupled to the network (Figs. 5-6B; ¶¶ 81, 97, 98).

Regarding claim 9, neither Bianco nor McMenimen explicitly teaches that the server requests intervention from manufacturing personnel when one or more manufacturing stages fall behind schedule; however, Official Notice is taken that it is old and well-known in the art of manufacturing to alert manufacturing personnel when a manufacturing stage falls behind schedule. This allows the personnel to make decisions that could rectify manufacturing delays, as needed. Such intervention might be especially crucial in high risk or emergency medical situations. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt the Bianco-McMenimen combination such that the server requests intervention from manufacturing personnel when one or more manufacturing stages fall behind schedule in order to allow manufacturing personnel to make decisions that could rectify manufacturing delays, as needed (e.g., in high risk or emergency medical situations).

Regarding claim 10, while the Bianco-McMenimen combination teaches that the server updates the patient with manufacturing progress information (as discussed above), the combination does not expressly teach the specific data recited in the claim (i.e., information relating to a delay caused by manufacturing slippage). This difference is only found in the non-functional descriptive material and is not functionally involved in the steps recited nor does it alter the recited structural elements; therefore, such a difference does not effectively serve to patentably distinguish the claimed invention over the prior art. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106. Nevertheless, Official Notice is taken that it is old and well-known in the art of manufacturing to alert a customer to manufacturing slippage, i.e., that a manufacturing stage has fallen behind schedule. This allows the customer to make product-related decisions or alternate plans accordingly. For example, some sort of intervention or alternate planning might be especially crucial in high risk or emergency medical situations. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt the Bianco-McMenimen combination such that the server updates the patient with information relating to a delay caused by manufacturing slippage in order to allow the

patient to make product-related decisions or alternate plans, as needed (e.g., in high risk or emergency medical situations).

[Claims 11, 13-21] Claims 11 and 13-21 recite limitations already addressed by the rejection of claims 1-10 above; therefore, the same rejection applies.

Additionally, regarding claims 11, 20, and 21, neither Bianco nor McMenimen expressly states that the message sent to a patient or treating professional computer is done so "in the absence of the patient prompting the server to send the message"; however, Official Notice is taken that it is old and well-known in the art of generating alerts to send alerts without direct human prompting. Such a practice provides human users with the convenience of receiving important information as soon as it becomes available (i.e., without human users having to spend additional time constantly checking for updated information). Since the Bianco-McMenimen generally discloses automated alerts to users regarding updates in manufacturing progress, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the Bianco-McMenimen combination to automatically send a message to a patient computer or a treating professional computer "in the absence of the patient prompting the server" in order to provides human users (such as patients and treating professionals) with the convenience of receiving important manufacturing progress information as soon as it becomes available (i.e., without human users having to spend additional time constantly checking for updated information).

Furthermore (regarding claim 7), as discussed in the rejection of claim 1 above, Bianco's patients log on to the system.

Regarding claim 18 and as discussed in the rejection of claim 1 above, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt the Bianco-McMenimen combination to supply one or more dental appliances in order to expand its customer base to the dental industry. Additionally, Official Notice is taken that it is old and well-known in the dental industry for a dentist or orthodontist to install dental appliances. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to market the Bianco-McMenimen combination to treating professionals, including dentists or orthodontists, in order to expand its customer base to the treating professionals in the dental industry.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Susanna M. Diaz  
Primary Examiner  
Art Unit 3694

December 26, 2006